

Application N. : 09/934031

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Remarks

The Office Action dated June 9, 2003, has been received and reviewed. Claims 1, 10, 23, and 31 have been amended. New claims 35-37 have been added. And claims 9, 14, 29, and 34 have been cancelled. The pending claims are claims 1-2, 4-8, 10-13, 15-28, 30-33, and 35-37. Reconsideration and withdrawal of the rejections are respectfully requested.

Objected to Claims

Applicants acknowledge that claims 9, 14, 29, and 34 were objected to as being dependent upon rejected base claims but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, Applicants have amended claim 1 to substantially include all of the elements of objected to claim 9. Further, Applicants have added new claims 35-37. New claim 35 is objected to claim 14 rewritten in independent form. New claim 36 is objected to claim 29 rewritten in independent form. And new claim 37 is objected to claim 34 rewritten in independent form. As such, Applicants submit that claims 1-2, 4-8, and 35-37 are in allowable form.

Claim Amendments

Claim 1 has been amended to substantially include all of the elements of original claim 9.

Claims 10, 23, and 31 have been amended to recite that the retroreflective beads include a coating including aluminum. Support for these amendments may be found, e.g., in the Specification at page 1, lines 25-27 and lines 30-32.

The amendments to the pending claims do not narrow the scope of such claims. Further, no new matter was added.

The 35 U.S.C. § 102(b) Rejections

Claims 1-2 and 6-8 were rejected under 35 U.S.C. § 102(b) as being anticipated by May (U.S. Patent No. 4,648,689). Applicants traverse this rejection.

However, to further move this case towards issuance, Applicants have amended claim 1 to substantially include all of the elements of objected to claim 9. As such, Applicants submit

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that claims 1-2 and 6-8 are in allowable form. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 10-13 were rejected under 35 U.S.C. § 102(b) as being Yoshitaka (Japanese Patent No. 3,193,440). Applicants traverse this rejection.

However, to further move this case towards issuance, Applicants have amended claim 10 to recite that the retroreflective beads include a coating including aluminum. Applicants submit that amended claim 10 is not anticipated by Yoshitaka because such reference does not teach each and every element of amended claim 10. Please note that Applicants will submit a translation of Yoshitaka in a forthcoming Supplemental Information Disclosure Statement.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference. *See* M.P.E.P. § 2131. Claim 10 recites an article that includes a foam backing including a first side and a second side, and a layer of retroreflective beads that are partially embedded in the first side of the foam backing, where the retroreflective beads include a coating including aluminum.

In contrast to claim 10, Yoshitaka teaches a reflective sheet having a foamed layer 14 and an adhesive layer 11 on the front surface of the foamed layer 14. *See* Yoshitaka, page 1, first paragraph. Glass beads 13 are dispersed and adhered to the foamed layer 14 using the adhesive layer 11. *Id.* The reflective sheet can be used as a decorative sheet material. *Id.* at page 5, first paragraph. Yoshitaka does not teach that the glass beads 13 have a coating that includes aluminum. Because Yoshitaka does not teach each and every element of independent claim 10, such claim is not anticipated by Yoshitaka.

Claims 11-13, which depend from independent claim 10, are not anticipated by Yoshitaka for the same reasons as presented above for claim 10. In addition, claims 11-13 each recite additional elements that further support patentability when combined with independent claim 10.

For at least the above reasons, Applicants submit that claims 10-13 are not anticipated by Yoshitaka. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. § 103(a) Rejections

Claims 4, 6-8, 23-28, and 30-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over May in view of Yoshitaka.

Applicants traverse this rejection and submit that claims 4, 6-8, 23-28, and 30-33 are not *prima facie* obvious for at least the following reasons. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Applicants submit that claims 4, 6-8, 23-28, and 30-33 are not *prima facie* obvious because the combination of May and Yoshitaka does not teach all of the elements of such claims. For example, claims 4 and 6-8 depend from independent claim 1 and, therefore, include all of the elements of claim 1. As described above, claim 1 has been amended to substantially include all of the elements of objected to claim 9. As such, the rejection of claims 4 and 6-8 in view of the combination of May and Yoshitaka is hereby rendered moot.

In regard to claims 23-28 and 30, independent claim 23 recites an article that includes a layer of retroreflective beads that are partially embedded in the second side of the foam backing, where the retroreflective beads include a coating including aluminum. In contrast to claim 23, May teaches an article having a retroreflective sheeting that includes a polymeric support sheet in which a monolayer of transparent microspheres or beads are embedded. See, May, column 3, lines 44-47. The glass beads carry a coating of reflective material such as aluminum over their embedded surfaces. *Id.* at column 3, lines 47-49. In other words, May teaches that the beads are embedded in a polymeric support sheet, not in a foam backing as is recited in claim 23 of the present invention.

Further, Yoshitaka teaches a reflective sheet having glass beads 13 dispersed in an adhesive surface 11 of a foamed layer 14. See Yoshitaka, page 5, first paragraph. In other words, Yoshitaka does not teach a layer of retroreflective beads partially embedded in the second side of a foam backing, where the retroreflective beads include a coating including aluminum. Because May and Yoshitaka, either alone or in combination, do not teach all of the elements of

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claim 23, such claim cannot be *prima facie* obvious in view of the combination of May and Yoshitaka.

Claims 24-28 and 30, which depend from claim 23, are not *prima facie* obvious for the same reasons as presented above for claim 23. In addition, claims 24-28 and 30 each recite additional elements that further support patentability over the combination of May and Yoshitaka.

In regard to claims 31-33, independent claim 31 recites an article including a medical tape capable of being comfortably adhered to human skin. Claim 31 further recites that the article includes a layer of retroreflective beads that are partially embedded in the non-adhesive side of the medical tape, where the retroreflective beads include a coating including aluminum. In contrast to claim 31, neither May nor Yoshitaka teach a medical tape capable of being comfortably adhered to human skin. Further, neither May nor Yoshitaka teach an article including a layer of retroreflective beads that are partially embedded in the non-adhesive side of the medical tape. Because May and Yoshitaka, either alone or in combination, do not teach all of the elements of claim 31, such claim is not *prima facie* obvious in view of May and Yoshitaka.

Claims 32-33, which depend from claim 31, are not *prima facie* obvious for the same reasons as presented above for claim 31. In addition, claims 32-33 each recite additional elements that further support patentability when combined with claim 31.

For at least the above reasons, Applicants submit that claims 4, 6-8, 23-28, and 30-33 are not *prima facie* obvious in view of the combination of May and Yoshitaka. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 1-2, 4-8, 23-28, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshitaka in view of Carte et al. (U.S. Patent No. 5,947,917).

Applicants traverse this rejection and submit that claims 1-2, 4-8, 23-28, and 30-33 are not *prima facie* obvious because the combination of Yoshitaka and Carte et al. does not teach all of the elements of such claims. For example, claim 1 has been amended to substantially include all of the elements of objected to claim 9. As such, Applicants submit that this rejection of claim 1 and claims 2 and 4-8, which depend from claim 1, is moot.

In regard to claims 23-28 and 30-33, as stated above in regard to the previous rejection of such claims under 35 U.S.C. § 103(a), Yoshitaka does not teach all of the elements of claims 23-

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28 and 30-33. The addition of Carte et al. does nothing to cure this deficiency already present in Yoshitaka.

For at least the above reasons, Applicants submit that claims 1-2, 4-8, 23-28, and 30-33 are not *prima facie* obvious in view of the combination of Yoshitaka and Carte et al.

Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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Conclusion

It is respectfully submitted that the pending claims are in condition for allowance.
Reconsideration and withdrawal of all rejections are respectfully requested.

No fees are believed to be due by submission of this paper. If this belief is in error, please charge any required fees to Deposit Account No. 13-3723. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

Sept 9, 2003
Date

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